

to examine the unelected species, which are rejoined. This requires precisely the same amount of work by the Examiner as the completely improper procedure being contemplated, i.e., (presumably) examination of the generic claim and an elected "restriction group."

Indeed, it is not even clear what procedure is being contemplated by the Examiner with respect to the generic claims. Is the Examiner refusing to examine *generic* claims such as claim 1 altogether? If so, what statutory or rule based authority gives the Examiner any right simply to refuse to examine generic claims? As the Courts have plainly indicated:

As a general proposition, an applicant has a right to have each claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action would not affect the rights of the applicant eventually to have each of the claims examined in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on the merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be defined by the examiner, rather than by the applicant, it is not inconceivable that a number of the fragments would not be described in the specification.

See, In Re Weber, Soder and Boksay 198 USPQ 328, 331 (C.C.P.A. 1978). *See also, In Re Haas* 179 USPQ 623, 624, 625 (*In Re Haas I*) (C.C.P.A. 1973) and *In Re Haas* 198 USPQ 334-337 (*In Re Haas II*) (C.C.P.A. 1978).

Precisely the problem indicated by the Court applies here. The independent claims at issue are *generic*. They are not even in Markush format. The combined restriction groups, in no way, capture the original claims on the merits. There is no way, no matter how many cases are filed, that Applicants can ever have their *claimed* invention examined, under the apparent logic of the Restriction Requirement.

Because of this problem, it has long been held that an Examiner flatly may not **reject** a particular generic claim on the basis that it represents "independent and distinct" inventions. *See, In Re Weber, Soder and Boksay, Supra*. The courts have definitively ruled that the statute authorizing restriction practice, i.e., 35 U.S.C. § 121, provides no legal authority to impose a

restriction requirement on a single claim, even if the claim presents multiple independently patentable inventions. See, *In Re Weber, Soder and Boksay*, *In Re Haas I* and *In Re Haas II*. In the cases set forth above, the courts expressly ruled that there is no statutory basis for rejecting a claim for misjoinder, despite previous attempts by the Patent Office to fashion such a rejection. As noted in *In Re Weber, Soder and Boksay*:

The discretionary power to limit one applicant to one invention is no excuse at all for refusing to examine a broad generic claim-- no matter how broad, which means no matter how many independently patentable inventions may fall within it.

See, *In Re Weber, Soder and Boksay* at 334.

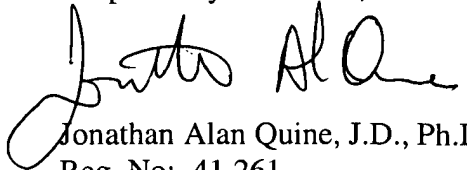
Accordingly, the restriction is completely improper. The appropriate basis for handling examination of this case is under election practices specified by 37 C.F.R. § 1.146. In addition to being the correct procedure in the present case, election practice is not any more burdensome than the procedure outlined by the Examiner, unless it is the Examiner's intent simply to refuse to examine the independent claims altogether.

In the event that appropriate election practice is used, Applicants elect the species represented by Group I, E, iii.

In the event that the requirement is maintained in its current form, Applicants formally request an Interview with the Examiner and the Examiner's SPE, prior to any additional official action.

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Attachments:

- 1) A transmittal sheet; and,
- 2) A receipt indication postcard.